

Docket No.: PF-0148-2 DIV
Response Under 37 C.F.R. 1.116 - Expedited Procedure
Examining Group 1652

Rejection under 35 U.S.C. 102

Independent claim 19, and its dependent claims 18, 20-22 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Yang et al. The Examiner argued that Yang et al teaches a cDNA encoding bovine pyrophosphatase, which has an amino acid sequence 96% identical to SEQ ID NO:1, and thus anticipates claim 19. Applicants respectfully traverse.

It is well settled in patent law that a reference is anticipating under 35 U.S.C. § 102 (b) only if **all** elements of the claimed invention are disclosed in the reference. *In re Paulsen*, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994). Claim 19 has been amended to recite a **human** polynucleotide sequence, whereas Yang et al disclosed a **bovine** pyrophosphatase. Thus, not all limitations are found in the cited reference, and the rejection of the claims at issue under 35 U.S.C. 102(b) is improper. The Examiner is respectfully requested to withdraw this rejection.

Rejection under double patenting

Claim 19 is rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 and 3 of U.S. Patent No. 5,843,665. Similar, claims 18 and 20-22 are rejected over claims 1-5 of U.S. Patent No. 5,843,665 for double patenting. Applicants respectfully traverse.

As pointed in the Office Action, a timely filed terminal disclaimer may overcome such double patenting rejection. The same double patenting rejection was raised in the previous Office Action dated December 23, 1999. The Examiner's attention is directed to the terminal disclaimer filed on March 23, 2000, in conjunction with the response to the previous Office Action. If the Examiner is not able to locate the terminal disclaimer in the file, Applicants would be happy to supply another copy upon request. Therefore, the instant double patenting rejection is overcome. The Examiner is respectfully requested to withdraw the rejection.

CONCLUSION

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance, and request that the Examiner withdraw the outstanding rejections. Early notice to that effect is earnestly solicited.


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If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact Applicants' Attorney at (650)855-0555.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108. This form is enclosed in duplicate.

Respectfully submitted,
INCYTE GENOMICS, INC.

Date: 8/31/00



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